

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
February 23, 2005

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

America Honda Motor Co., Inc.
v.
TBC Corporation

Opposition No. 91121151
to application Serial No. 75874915
filed on December 17, 1999

Anthony J. Fletcher of Fish & Richardson P.C. for America
Honda Motor Co., Inc.

Marsha G. Gentner of Jacobson, Holman PLLC for TBC
Corporation.

Before Seeherman, Hohein and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

TBC Corporation has filed an application to register
the mark SHADOW in typed capital letters for "tires."¹
Registration has been opposed by America Honda Motor Co.,
Inc. under Section 2(d) of the Trademark Act. Opposer

¹ Serial No. 75874915, filed on December 17, 1999, which is based
on a bona fide intent to use the mark in commerce.

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alleges that it is the exclusive licensee in the United States of all trademarks owned by Honda Motor Co. (Japan); that it is the exclusive distributor of the goods manufactured by Honda Motor Co.; and that it is in the business of selling, promoting and distributing vehicles, including automobiles, motorcycles, all-terrain vehicles, and their respective parts, related services and merchandise. Also, opposer alleges that Honda Motor Co. is the owner of the following registrations: Registration No. 1,604,515 for the mark SHADOW for "motorcycles and motorcycle structural parts;" Registration No. 2,202,312 for the mark SHADOW for "jewelry" and "fancy goods"; Registration No. 2,260,820 for the mark SHADOW AERO for "motorcycles and structural parts thereof;" Registration No. 2,363,335 for the mark SHADOW AERO for "paper goods and printed matter, namely, magazines, pamphlets, brochures, newsletters and books on the subject of motorcycles, posters, and decals;" and Registration No. 2,285,785 for the mark SHADOW AMERICAN CLASSIC EDITION for "printed matter in the nature of publications to be distributed to purchasers of registrant's motorcycles"; "clothing, namely, shirts and hats, sold through authorized motorcycle dealers"; and "replicas of the registrant's motorcycles and accessories therefor sold by registrant and its authorized dealers."

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Further, opposer alleges that since prior to the filing date of applicant's application, it has used these registered marks, and that applicant's mark is likely to cause confusion and dilute such marks.

Applicant, in its answer, denied the salient allegations of the notice of opposition and asserted as affirmative defenses that the opposition is barred by laches, acquiescence and/or estoppel.

The record consists of the file of the involved application; the testimony deposition (with exhibits) of opposer's witness, Robert J. Gurga; opposer's notices of reliance on certified copies of the pleaded registrations and the file of Opposition No. 91125235; the testimony deposition (with exhibits) of applicant's witness Gary M. Paulson; and applicant's notices of reliance on third-party registrations and applications, and the file of Cancellation No. 9226171.

Opposer and applicant filed main briefs on the case and opposer filed a reply brief. An oral hearing was held.

Preliminary Matters

Before turning to the merits of the case, we must discuss opposer's argument that applicant has "admitted" that there is a likelihood of confusion in this case; applicant's argument that opposer is estopped from arguing that there is a likelihood of confusion in this case; and certain evidentiary objections raised by applicant.

First, opposer argues that applicant has "admitted" that there is a likelihood of confusion in this case because in pending Opposition No. 91125325 involving applicant (as the opposer) and a third party, applicant has alleged that the third-party's mark INDIAN SPIRIT for motorcycles is likely to cause confusion with applicant's marks GRAN SPIRIT, GRAND SPIRIT and WILD SPIRIT for tires.

Although the file of Opposition No. 91125325 may certainly be introduced into evidence, applicant's position in that opposition is not an admission on the ultimate issue of likelihood of confusion in this case. A party's position on the issue of likelihood of confusion in another proceeding is not binding on the Board, but rather "merely illuminative of shade and tone in the total picture and does not relieve the decision maker of the burden of reaching his own conclusion on the entire record." *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). Thus, while we will consider

opposer's argument with respect to applicant's position in the other opposition, our determination of whether there is a likelihood of confusion in this case is based on the facts and record herein.

Second, applicant argues that opposer is estopped from arguing that there is a likelihood of confusion in this case because "the owner of the pleaded mark(s) on which the opposition is based and from whom [opposer] claims its rights as a distributor, has effectively conceded that the current application should be granted." (Brief, p. 1).

Opposer's parent company, Honda Motor Co., after initially opposing an application filed by applicant in Canada to register the SHADOW mark for tires, entered into a written settlement agreement with applicant whereby Honda Motor Co. consented to registration of the mark and acknowledged that there is no likelihood of confusion. Applicant maintains that "[i]f the trademark owner cannot be damaged by the registration [applicant] seeks, then those parties claiming their rights from the trademark owner (e.g. opposer herein) cannot be damaged either." (Brief, p. 1). This argument, however, is without merit since an opposer's right to object to an applicant's registration of a mark in the United States is completely independent of the respective foreign trademark rights of the parties. See *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973) and *William*

Sanderson & Son Ltd. v. Fernandes & Co., Ltd., 137 USPQ 165 (TTAB 1963). Thus, the fact that opposer's parent Honda Motor Co. entered into an agreement with respect to applicant's registration of the SHADOW mark in Canada is not determinative of whether applicant is entitled to registration of the SHADOW mark in the United States.

Finally, attached to applicant's brief on the case is a list of the exhibits introduced during the testimony of opposer's witness Mr. Gurga, to which applicant objects. Applicant does not explain its objections in this attachment, but instead simply cites to one or more of the Federal Rules of Evidence (e.g., "Exhibit 2 - F.R.E. 602, 802"). It is not enough that a party which objects to certain evidence simply cite to a particular rule. Rather, the objecting party should give some reason(s) for its objection(s). In view of applicant's failure to give any reasons for its objections in the attachment, we decline to consider it further.

However, at page 16 of its brief on the case, applicant has discussed, in particular, its objections to opposer's exhibits 7 and 12. Opposer's exhibit 7 consists of sales revenue information for the SHADOW motorcycles and exhibit 12 consists of a summary of the estimated number of SHADOW motorcycles manufactured during 1983-2000 that are still in operation. Applicant has objected to these exhibits on the

grounds of hearsay and specifically that opposer's witness, Mr. Gurga, did not have personal knowledge of the information therein. In particular, applicant argues that Mr. Gurga neither prepared nor supervised the preparation of the documents and did not know who prepared the documents. Further, applicant contends that Mr. Gurga admitted during his testimony deposition that he is not the person within opposer's organization who has personal knowledge of the company's sales figures and that he did not know how the information relating to the estimated number of motorcycles still in operation was derived.

Opposer, on the other hand, argues that exhibits 7 and 12 are admissible as business records and that Mr. Gurga has the requisite personal knowledge with respect to the exhibits because he testified that individuals within his department and under his ultimate supervision and control generated these documents.

We find applicant's objections to be without merit in view of the fact that the documents are summaries of business information and were prepared by individuals under Mr. Gurga's supervision.

The Parties

Opposer

Opposer took the testimony of Robert Gurga, senior manager, product planning group, of America Honda's

motorcycle division. Mr. Gurga testified that he has worked for opposer for twenty-five years and that he has been in his current position since January 1, 2000. In his position, he oversees four departments, "Market Information and Technology," "Motorcycle Accessories Sales and Marketing," "Product Evaluation," and "Product Planning." Mr. Gurga identified an agreement between opposer and its parent, Honda Motor Co., which grants opposer exclusive rights to import and distribute Honda products in the United States. Among the products which Honda Motor Co. produces are automobiles, motorcycles, all terrain vehicles and power equipment. Further, Mr. Gurga testified that opposer is authorized to use and license others to use the marks owned by Honda Motor Co.

Mr. Gurga testified that the first SHADOW motorcycle sold in the United States by opposer was in 1983, as reflected in the Honda Motorcycle Identification Guide which was introduced during his testimony. He testified that SHADOW motorcycles have been continuously sold by opposer in the United States since that time.² The SHADOW line comprises more than sixty models of motorcycles. Opposer advertises its motorcycles on national television, on radio and in publications.

² Opposer's sales figures were submitted under seal.

Applicant

TBC Corporation is in the business of marketing and distributing passenger car and light truck replacement tires and wheels, and automobile parts and accessories, in and through the automotive aftermarket. Applicant has one wholesale division, TBC Private Brands Division, and two retail divisions, Tire Kingdom and Big O Tires.

Applicant distributes tires throughout the United States and Canada under the brands MULTIMILE, CORDOVAN, VANDERBILT and SIGMA. Within each brand there are a number of different models, including SHADOW within the SIGMA line. The SIGMA SHADOW is a tire used in passenger vehicles. Applicant sells 90% of its SIGMA SHADOW tires through its retail Tire Kingdom division; the remaining tires are sold by the TBC Private Brands Division to independent wholesalers or retailers.

Applicant adopted the SHADOW mark in the summer of 1999. It has been used since then to designate a model within the SIGMA line of tires. The SHADOW mark appears on the tire itself. In addition, the mark is used in marketing materials, on tire labels, in catalogs and in connection with other promotional activities. Applicant has spent approximately \$6.5 million at the retail level on advertising and promotion of SHADOW tires since 1999. From early 2000 through February 2004, applicant sold 1,550,168

SHADOW tires, accounting for \$43.6 million in wholesale sales and revenues.

Standing and Priority

Opposer has demonstrated its standing by virtue of the fact that it is the exclusive distributor of Honda products, including motorcycles bearing the SHADOW mark, in the United States.

With respect to priority, opposer submitted under notice of reliance certified copies of the registrations pleaded in the notice of opposition. These registrations show title in opposer's parent company Honda Motor Co. (Japan). Applicant argues that opposer may not rely on such registrations for purposes of priority because opposer is not the owner of the registrations and that in order to establish its priority, opposer must prove prior use of the SHADOW mark in the United States.

It is well settled that "the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner." TBMP §704.03(b)(1)(B). See also *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) [An opposer cannot rely on registrations owned by a parent: "Opposer is not the registrant of any of the registrations filed with its notice under Trademark Rule

2.123(c) and said registrations stand in the same category as if they were owned by independent and unaffiliated companies."]. Thus, opposer may not rely on the pleaded registrations to establish its priority, but instead must prove prior use of the SHADOW mark.³

In this regard, opposer's witness, Mr. Gurga, testified that opposer is a subsidiary of Honda Motor Company and the exclusive distributor of Honda products in the United states. Opposer introduced a copy of the exclusive distribution agreement between Honda Motor Company and opposer. Further, opposer introduced excerpts from the Honda Motorcycle Identification Guide which show that various models of SHADOW motorcycles were offered for sale between 1983 and 2000. For example, from 1983 to 1986 opposer offered the SHADOW 500; from 1993 to 2000 it offered the SHADOW VLX DELUXE; from 1998 to 2000 it offered the SHADOW SPIRIT and SHADOW AMERICAN CLASSIC EDITION TOURER, and in 2000 it offered the SHADOW SABRE. In addition, opposer made of record pages downloaded from its website which show that in 1993 opposer offered, inter alia, the SHADOW VLX, SHADOW VLX Deluxe, and SHADOW SPIRIT 750. Further, opposer made of record sales information relating

³ In particular, opposer must prove use of the SHADOW mark prior to the earliest date upon which applicant may rely, namely the summer of 1999.

to SHADOW motorcycles from 1983 through 2002 and examples of advertisements used from 1983 until 2000.

We find that opposer's evidence clearly establishes opposer's use of the SHADOW mark for motorcycles since 1983, which is prior to the earliest date upon which applicant can rely in this proceeding, namely, the summer of 1999. Thus, opposer has proven its priority in this proceeding.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.

Turning first to a consideration of the marks, opposer's SHADOW mark and applicant's SHADOW mark are identical in terms of appearance, sound, connotation and overall commercial impression. This fact weighs in favor of a finding of likelihood of confusion.

We turn next to a consideration of opposer's and applicant's goods. It is not necessary that the respective goods be identical or even competitive in order to support a

finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the source of the respective goods. *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244 (TTAB 1984); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application, and not in light of what such goods are asserted to actually be. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, where an applicant's goods are broadly described as to their type, it is presumed that the application encompasses all goods of the type described therein, and that the identified goods are sold through all channels of trade which would be normal for those goods, and that they would be purchased by all potential purchasers thereof. *In re Elbaum*, 211 USPQ

639 (TTAB 1981). Further, where the applicant's mark is identical to the opposer's mark, as it is in this case, there need only be a viable relationship between the respective goods in order to find that a likelihood of confusion exists. In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983).

Applying these principles to this case, we find that applicant's tires and opposer's motorcycles are related products. In the absence of any limitations in the involved application, we must assume that applicant's tires include a type that would be used on motorcycles, i.e., motorcycle tires. Motorcycle owners will, after their original tires wear out, be prospective purchasers for replacement tires. Motorcycles and motorcycle tires are clearly complementary products that are purchased by a common class of consumers. Purchasers familiar with opposer's SHADOW motorcycles, upon encountering applicant's SHADOW tires, may well believe that such tires are designed for use on opposer's SHADOW motorcycles. We find therefore that opposer's and applicant's goods are sufficiently related that when sold under the identical SHADOW mark confusion is likely to occur. In the past, the Board has held that when the same or substantially identical marks are applied to vehicles and tires, confusion is likely. See Jetzon Tire & Rubber Corp. v. General Motors Corp., 177 USPQ 467 (TTAB 1973) and

General Motors Corp. v. Pacific Tire & Rubber Co., 132 USPQ 562 (TTAB 1962).

Applicant argues that marks consisting of the word "shadow" are weak marks and are therefore entitled to a limited scope of protection. In support of this argument, applicant submitted copies of third-party applications and registrations of marks containing the word SHADOW. The probative value of this evidence is very limited in our determination of the issue of likelihood of confusion in this case. In particular, third-party registrations are entitled to little weight on the question of likelihood of confusion. Such registrations are not evidence that the marks therein are in use or that the public is familiar with them. See AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Moreover, in this case, none of the marks in the third-party registrations is as similar to opposer's mark as is applicant's mark, which is identical to opposer's mark SHADOW. Further, the third-party registrations are for goods which are different from those involved in this case.⁴ In addition, the third-party

⁴ For example, among the registrations relied upon are Registration No. 2,637,198 for the mark SILVER SHADOW for boats; Registration No. 2,792,453 for the mark THE SHADOW CONSPIRACY for structural parts of bicycles; Registration No. 2,482,400 for the mark MECHANIC'S SHADOW for mobile carts for tools and parts; and Registration No. 2,439,088 for the mark SHADOW HAWK for motorized golf carts.

applications are evidence of only the fact that the applications were filed and are of no probative value.

Further, applicant argues that purchasers of opposer's motorcycles, in particular, are sophisticated purchasers. In support of this point, applicant points to the testimony of opposer's witness Mr. Gurga, who testified that the prospective purchasers of opposer's motorcycles conduct research before making a motorcycle purchase and that such purchasers tend to be older than purchasers of other brands, and have high incomes and education levels. We recognize that purchasers are likely to exercise care in the selection of motorcycles but when the identical mark is used on closely related goods, the relevant purchasers are likely to be confused, despite the care taken.

Also, applicant argues that the likelihood of confusion is diminished because of opposer's "consistent and prominent use of the HONDA mark" on opposer's motorcycles. (Brief, p. 19). Opposer, however, has not relied on use of a composite HONDA SHADOW mark and the evidence shows that opposer uses the SHADOW mark separate from the mark HONDA. Therefore, it is appropriate to consider opposer's mark SHADOW per se in our determination of likelihood of confusion.

With respect to applicant's contention that there has been no actual confusion, as discussed above, there is a legal presumption that applicant's goods encompass

motorcycles tires and that such tires are marketed to motorcycle owners. However, there is no evidence that applicant markets such tires to this class of purchasers. On the contrary, applicant asserts that it markets only passenger car and light truck replacement tires. As noted by opposer, "[t]he fact that [applicant] has not, yet anyway, distributed motorcycle tires might have a bearing on the lack of evidence of actual confusion..." (Reply brief, p. 6). In other words, there is no basis for concluding that there has been any meaningful opportunity for actual confusion to have occurred. Thus, the absence of any instances of actual confusion is not legally significant. See *Gillette Canada Inc. v. Ramir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

We conclude therefore that purchasers familiar with opposer's SHADOW motorcycles, upon encountering applicant's SHADOW mark for tires, would be likely to assume that such products originate with or are in some way associated with the same source.

Decision: The opposition is sustained and registration to applicant is refused.